

REMARKS/ARGUMENTS

The claims are 2-9. Claims 7 and 9 have been amended to expressly recite that the profiled cover is suitable without the compensating strip to be employed between two floor coverings having the same height. Support may be found, *inter alia*, in the disclosure in the paragraph bridging pages 2-3. Reconsideration is expressly requested.

Claims 5 and 6 were considered to have allowable subject matter; however, the remaining claims were rejected on the basis of the prior art. Specifically, claims 7-9 were rejected under 35 U.S.C. 103(a) as being unpatentable over *Stanchfield U.S. Patent No. 6,860,074*. The remaining rejected claims 2-4 were rejected under 35 U.S.C. 103(a) as being unpatentable over *Stanchfield* in view of *Neuhofer U.S. Design Patent No. D 542,941* alone (claims 2-3) or further in view of *Kemper U.S. Patent No. 6,345,480* (claim 4). The Examiner indicated, *inter alia*, that Applicant's arguments presented in the February 24, 2009 Preliminary Response in RCE with respect to the ability of

Applicant's profiled cover to be used on floor surfaces that have the same height as well as floor surfaces that were uneven need not be considered because this feature was not recited in the rejected claims.

Accordingly, Applicant has amended claims 7 and 9 to expressly recite that the profiled cover is suitable without the compensating strip to be employed between two floor coverings having the same height and respectfully traverses the Examiner's rejection for the following reasons.

The differences between Applicant's profiled cover and method were substantially set forth in Applicant's February 24, 2009 Preliminary Response in RCE. As discussed in Applicant's February 24, 2009 Preliminary Response in RCE, Applicant's profiled cover as recited in claim 1 does not represent a "mere" reversal of the working parts of *Stanchfield* as a new and useful purpose is accomplished by the rearrangement of the working parts. As expressly stated *In re Einstein* 46 F.2d 373, 8 U.S.P.Q. 166, 167 (1931) relied on by the Examiner: "There must

be some new device or some new and useful purpose accomplished."

Here, a new and useful purpose is accomplished with Applicant's profiled cover that cannot be achieved by any of the prior art as discussed in detail in Applicant's February 24, 2009 Preliminary Response in RCE and as expressly recited in claims 7 and 9 as amended herein.

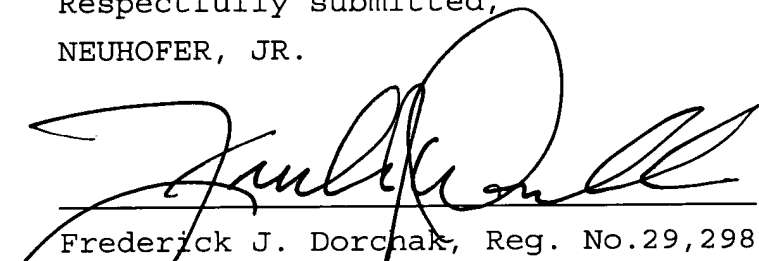
Moreover, as set forth in Applicant's February 24, 2009 Preliminary Response in RCE, the unexpected result of versatility achieved by Applicant's profiled cover as recited in claim 9 as amended rebuts any assertion of *prima facie* unpatentability based on the supposed "mere" reversal of the working parts of the device of *Stanchfield*. Although the Examiner asserts that there is nothing structurally about the cover that would make it less susceptible to breaking because of the groove in it, it is respectfully submitted that the Examiner's argument overlooks that it was clear to one of ordinary skill in the art of floor coverings that it was undesirable to produce covering flanges with grooves in the body of the covering flange because of the weakening effect on the profile cover as evidenced by the profile

covers in the prior art cited by the Examiner which show no grooves in the body of covering flanges. The Examiner's assertion to the contrary is simply unsupported by any of the cited references.

Accordingly, it is respectfully submitted that claims 7 and 9 as amended, together with claim 8 which depends on claim 7 as amended and claims 2-4 which depend directly or indirectly on claim 9 as amended, are patentable over the cited references, together with claims 5 and 6 which the Examiner has indicated contain allowable subject matter.

In summary, claims 7 and 9 have been amended. In view of the foregoing, it is respectfully requested that the claims be allowed and that this application be passed to issue.

Respectfully submitted,
NEUHOFFER, JR.

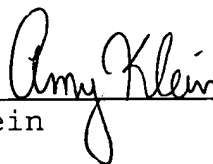


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Amy Klein

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